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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Applicant              | Salvador Cababie  |
| Applied for Mark       | BAJA TU SEGURO.COM  |
| Correspondence Address | GREGG A PARADISE<br>LERNER DAVID LITTENBERG KRUMHOLZ & MENTLIK LLP<br>600 SOUTH AVENUE WEST<br>WESTFIELD, NJ 07090<br>UNITED STATES<br>trademarkadmin@lernerdavid.com |
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| Filer's Name           | Gregg A. Paradise   |
| Filer's e-mail         | gparadise@lernerdavid.com,trademarkadmin@lernerdavid.com  |
| Signature              | /Gregg A. Paradise/   |
| Date                   | 12/08/2015  |

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

|                        |   |                     |
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| In re Application of   | : |                     |
| Salvador Cababie       | : |                     |
|                        | : | Law Office: 103     |
| Serial No. 86/265,949  | : |                     |
|                        | : | Examining Attorney: |
| Filed: April 29, 2014  | : | Theodore McBride    |
|                        | : |                     |
| Mark: BAJATUSEGURO.COM | : |                     |
| _____                  | X |                     |

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
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**APPLICANT'S APPEAL BRIEF**

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## **I. INTRODUCTION**

Applicant Salvador Cababie hereby submits its Appeal Brief pursuant to 37 C.F.R. § 2.142(b)(1). The appeal comes following a final decision of the Examining Attorney refusing registration of Applicant's mark BAJATUSEGURO.COM plus design under Lanham Act §§ 2(e)(1) and 2(d), 15 U.S.C. §§ 1052(e)(1) and 1052(d). Applicant maintains that when Applicant's mark is properly translated under the doctrine of foreign equivalents in view of the mark in its entirety, Applicant's mark is not merely descriptive of Applicant's services. The Examining Attorney's proffered machine translation is incorrect taken in context and inferior to the translation submitted in Applicant's declaration of a native Spanish speaker.

## **II. DESCRIPTION OF THE RECORD AND RECITATION OF THE FACTS**

Applicant seeks registration on the Principal Register of its mark, BAJATUSEGURO.COM plus design, for insurance brokerage, reinsurance underwriting, in International Class 36. The application was filed on April 29, 2014 and received U.S. Trademark Application Serial No. 86/265,949.

The Examining Attorney initially refused registration of Appellant's mark, BAJA TU SEGURO, in an Office Action dated August 14, 2014, contending that the mark was merely descriptive of Applicant's services. Namely, applying the doctrine of foreign equivalents, the Examining Attorney alleged that BAJA TU SEGURO translates to LOWER YOUR INSURANCE.

In the initial response, filed on February 17, 2015, Applicant submitted that BAJA TU SEGURO is properly translated as DOWNLOAD YOUR INSURANCE in the context of the mark, and therefore is not merely descriptive of Applicant's services. In support, Applicant submitted Google translations of "bajar" as Exhibits 1 and 2, as well

as a declaration of a person proficient in Spanish regarding the translation of “bajar” as “download.” In the alternative, Applicant submitted that the mark would be considered a true “double entendre.”

Next, on March 12, 2015, the Examining Attorney issued a Final Action, again refusing to register the mark based on descriptiveness, reiterating the previously presented rejections.

In response to the Final Action, on September 11, 2015, Applicant simultaneously filed a Notice of Appeal and requested reconsideration of the Examining Attorney's final refusal. In the Request for Reconsideration, Applicant submitted again that the proper translation of the mark is DOWNLOAD YOUR INSURANCE, citing further support. Cited support included translations of “bajar” from the Merriam-Webster Spanish-English dictionary in Exhibit A, varying definitions of the term “blue” in Exhibit B, the previously submitted declaration by a person proficient in Spanish relabeled as Exhibit C, as well as three registrations from the Mexican Patent Office of the BAJATUSEGURO.COM mark in Exhibits D-G. As per Applicant's request, the appeal was suspended pending consideration of the request.

On October 7, 2015, the Examining Attorney denied Applicant's request for reconsideration.

### **III. STATEMENT OF THE ISSUES**

The issues on this appeal are how Applicant's mark BAJATUSEGURO.COM is properly translated and whether the translated mark as a whole is descriptive of Applicant's services.

**IV. APPLICANT'S MARK, WHEN PROPERLY VIEWED IN ITS ENTIRETY, IS NOT DESCRIPTIVE OF APPLICANT'S SERVICES**

**A. Applicant's Mark Is Not Descriptive When Translated Under The Doctrine Of Foreign Equivalents In Context**

Applicant submits that, in context, the ordinary American purchaser knowledgeable in Spanish would translate Applicant's mark to be DOWNLOAD YOUR INSURANCE. The doctrine of foreign equivalents is applied when it is likely that an ordinary American purchaser would "stop and translate" the foreign term into its English equivalent. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 (Fed. Cir. 2005). The ordinary American purchaser refers to "all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English." *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352 (Fed. Cir. 2009). For BAJATUSEGURO.COM, purchasers proficient in Spanish are those who would be expected to translate the words into English.

Translation, however, does not happen in a vacuum. Certain words have different meanings depending on the context in which they are found. As stated in T.M.E.P. § 1207.01(b)(vi)(B), when determining the appropriate English translation of the foreign wording in the mark, an examining attorney should view the translations in the context of any significant features in the mark, such as design or wording elements, the identified goods and/or services in the application, the relevant marketplace, and the specimen. The context of Applicant's mark includes ".COM" at the end of the mark, which signals to the ordinary purchaser a relationship to the Internet. Furthermore, Applicant's services are exclusively offered online, as stated in the amended description of services. Therefore, Applicant's mark has context to support the translation of BAJA as DOWNLOAD, regardless of what the principal translation may be.

Further, the ordinary American purchaser knowledgeable in Spanish would know that BAJAR should be translated as DOWNLOAD in the context of BAJATUSEGURO.COM. The Examining Attorney consulted online mechanical translators to conclude that BAJATUSEGURO.COM is translated to “low/lower your insurance” and that “download your insurance” is translated to “descargar su seguro” in Spanish. However, by merely inputting “BAJA TU SEGURO” into the online mechanical translators, the Examining Attorney is not taking into consideration the context provided by the “.COM” in Applicant’s mark. Rather, as shown in the Google Translate results appended to the initial response, Exhibits 1 and 2, and #6 of the *Merriam-Webster Spanish-English Dictionary* (Exh. A), “bajar,” when used in context of computing or the Internet, means “to download.”

The Declaration of Vianey Romo de Vivar (*See* Exh. C) provides compelling evidence supporting this translation of “baja” in context of the mark. As stated in the declaration, Romo de Vivar is proficient in both English and Spanish. (*Id.* ¶¶ 2-3.) As such, Romo de Vivar represents an ordinary American purchaser knowledgeable in Spanish. Romo de Vivar states that she would translate “baja” to mean “download” or another similar English word or phrase, when “baja” is used in relation to the Internet. (*See* Exh. C ¶ 6.) She also states that she associates “.COM” with goods or services provided on the Internet and would therefore translate Applicant’s mark to mean DOWNLOAD YOUR INSURANCE. (*See id.* ¶ 9.) Consequently, when taken in the context of the full mark, a Spanish speaker would interpret BAJATUSEGURO.COM to mean DOWNLOADYOURINSURANCE.COM.



While mechanical translators like those consulted by the Examining Attorney may not capture nuance of idiomatic phrases, the ordinary purchaser would translate marks based on common idioms. Because “bajar” is a common idiom in Spanish meaning “to download” that cannot be translated directly to English, though mechanical translators may translate BAJAR to LOWER, the ordinary purchaser can nevertheless translate BAJAR to DOWNLOAD, given the proper context. Idioms often cannot be translated to other languages and retain the same meaning. An example of an idiom in English would be the phrase “feeling blue.” The word “blue,” without more, is most likely to mean “of a color intermediate between green and violet, as of the sky or sea on a sunny day.” (Exh. B.) However, in the idiom “feeling blue,” “blue” takes on a meaning of “melancholy, sad, or depressed.” (*Id.*) The idiom “feeling blue” does not make sense when translated into other languages because only English speakers understand the meaning behind the idiom. The nontranslatable nature of idioms is clearly seen in the various phrases in different languages analogous to “kick the bucket” translated to English provided on Wikipedia:

**Kurdish:** *Daya takhtakayaa* 'to hit the wood. a wooden table dead people are washed on.

**Arabic:** *Wad'aa*” he said goodbye

**Afrikaans:** *lepel deur die dak steek* 'to push a spoon through the ceiling (roof)',

**Bulgarian:** *ѓа рѓтнеѓ камѓаната* 'to kick the bell'

**Czech:** *natáhnout bačkory* 'pull the slippers'

**Danish:** *at stille træskoene* 'to take off the clogs',

**Dutch:** *het loodje leggen* 'to lay the piece of lead' or *de pijp aan Maarten geven* 'to give the pipe to Maarten',

**Farsi:** *daare faani raa vedaa* 'goft' said goodbye to the mortal dwelling',

**Filipino:** *magbalat-kayo* 'to pretend to be someone he's not' or 'to hide one's true identity'

**Finnish:** *potkaista tyhjää* 'to kick the void' or *heittää veivinsä* 'to toss away the crank' or *kasvaa koiranputkea* 'to be growing cow parsley' or *heittää lusikan nurkkaan* 'to toss the spoon to the corner' or *oikaista koipensa* 'to stretch the shanks'

**French:** *manger des pissenlits par la racine* 'to eat dandelions by the root' or *casser sa pipe* 'to break his pipe' or *passer l'arme à gauche* 'pass the weapon to the left',

**German:** *den Löffel abgeben* 'to give the spoon away' or *ins Gras beißen* 'to bite into the grass' or *sich die Radieschen von unten ansehen* 'look at the radishes from underneath',

**Hindi:** *Patta kat jana* 'to cut the leaf'

**Hungarian:** *Feldobja a lábát* 'to throw his foot up' or *Fűbe harap* 'to bite into the grass' or *Alulról szagolja az ibolyát* 'to smell the viola from underneath' or *Elpatkolt* 'to fail shoeing (a horse)',

**Greek:** *τινάζω τα πέταλα* 'to shake the horse-shoes',

**Icelandic:** *Að geispa golunni* 'to yawn the breeze',

**Irish:** "Dia dhuit" 'hello', literally translates to "God to you". The response to this is "Dia is Mhuire duit" which translates to 'God and Mary to you'. The Irish language has been heavily influenced by Christianity.

**Italian:** *tirare le cuoia* 'to pull the skins',

**Latvian:** *nolikt karoti* 'to put the spoon down'

**Lithuanian:** *pakratyti kojas* 'to shake the legs',

**Neapolitan:** *s'ha fatt 'a cartell* 'to made the folder',

**Norwegian:** *å parkere tøflene* 'to park the slippers', *sjekke ut* 'check out', *legge inn årene* 'pull in the oars', *takke for seg* 'thank for yourself', *slukke og låse* 'turn off and lock', *vandre* 'wander', *ta kvelden* 'call it a night',

**Polish:** *kopnąć w kalendarz* 'to kick the calendar', *wyciągnąć kopyta* 'to stretch the hooves', *wąchać kwiatki od spodu* 'to smell the flowers from underneath', *wsiąść w czarny autobus* 'to get on a black bus', *pójść na tamten świat* 'go to the other world', *walnąć w ramy* 'to hit the frame',

**Portuguese:** *bater as botas* 'to beat the boots', *esticar o pernil* 'to stretch the leg', or *fazer tijolo* 'to make a brick', plus *comer capim pela raiz* 'to eat grass by the root', *abotoar o paletó* 'to button up the blazer/coat', *esticar as canelas* 'to stretch the shanks',

**Romanian:** *a da colțul* 'to turn the corner', or *i-a sunat ceasul* 'his clock has rung',

**Russian:** *сыграть в ящик* (sygrat' v yaschik) 'to play into the box', *дать дуба* 'to give the oak', *откинуть копыта* 'to throw back the hoofs'

**Slovenian:** *šel je rakom žvižgat* 'he went to whistle to the crabs',

**Spanish:** *estirar la pata* 'to stretch the leg' or *palmarla* 'to pop off'

**Swedish:** *trilla av pinnen* 'to roll off the stick' very similar to 'walk the plank'. (as in a parrot or other bird suddenly dying and falling off its perch), *ta ner skylten* 'take the sign down' or *sätta skorna* 'take the shoes off'

**Tlingit:** *dákde kákw aawayaa* 'to take one's basket into the woods',

**Turkish:** *Nalları dikti* 'put the horseshoes in the air', as in a horse dropped dead to the ground,

**Ukrainian:** *впізати дуба* 'to cut the oak (as in building a coffin)',

**Urdu:** *Haathi nikal gaya dum phans gaya*

□ ☞ 'The elephant escaped but his tail got stuck'

□ ☞ یگ لکن

<https://en.wikipedia.org/wiki/Idiom>.

In all of these instances, a simple mechanical translation will result in an incorrect meaning. Such is the nature of idioms. In the same way, Spanish speakers will interpret “bajar” as download in the context of Applicant’s mark despite the fact that a direct, literal translation appears to mean something different. The mark, BAJATUSEGURO.COM, provides the “.com” at the end as context for the mark as a whole; namely it signals a relationship to the Internet. As discussed above and as provided in the previously filed declaration (Exh. C), those well versed in Spanish know the common use of “bajar” with respect to the Internet. Therefore, purchasers familiar with Spanish would naturally translate the mark to be DOWNLOADYOURINSURANCE.COM.

DOWNLOADYOURINSURANCE.COM is not merely descriptive of a feature or goal of Applicant’s services. Applicant’s services include brokering insurance policies and underwriting reinsurance. Purchasers may use Applicant’s services to buy a policy to protect certain items they own. These goods and services are not downloadable, nor do they involve downloading an insurance policy. Therefore in view of the proper translation of Applicant’s mark in context, BAJATUSEGURO.COM is not merely descriptive of Applicant’s services.

As further support that this mark is worthy of registration, the Mexican Patent Office has registered BAJATUSEGURO.COM with its design three times. (Exhs. D-F.) Certified copies of the registrations are provided in Exhibit G. The Mexican Patent Office, which is knowledgeable in trademark law, including descriptiveness, as well as, obviously, the Spanish language, registered the mark in international classes 9, 16, and 35. In particular, the registration in class 35 describes the services as “price

comparison services in the insurance industry.” (Exh. F.) These services are comparable to the services in Applicant’s U.S. application, which are “insurance brokerage and reinsurance underwriting services offered via a global computer network.” Therefore, Applicant submits that because American purchasers familiar with Spanish would translate Applicant’s mark to mean DOWNLOADYOURINSURANCE.COM, Applicant’s mark is not descriptive of Applicant’s services, and respectfully requests that the application be allowed.

**B. Applicant's Mark Is Not Descriptive Because It  
Comprises A Double Entendre Having At Least  
One Meaning Not Descriptive Of Applicant's Services**

As a second basis, to demonstrate that Applicant's mark is not descriptive, Applicant's mark BAJATUSEGURO.COM plus design also creates a double entendre having a double connotation as applied to Applicant's services. It is well settled that a mark comprising a double entendre "will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services." T.M.E.P. § 1213.05(c). According to T.M.E.P. § 1213.05(c), a double entendre is an expression that has a double connotation or significance as applied to the goods or services.

Even if LOWER YOUR INSURANCE and DOWNLOAD YOUR INSURANCE were both acceptable translations of Applicant's mark, BAJATUSEGURO.COM would then be considered a true “double entendre.” The Examining Attorney has based refusal of the registration of Applicant’s mark in both Office Actions on the premise that BAJATUSEGURO.COM is translated to LOWER YOUR INSURANCE, and that LOWER YOUR INSURANCE is descriptive of Applicant’s services. Even assuming LOWER YOUR INSURANCE was a proper translation of Applicant’s mark in context,

as presented in Section A above, DOWNLOAD YOUR INSURANCE is also an acceptable meaning of BAJATUSEGURO.COM that is not merely descriptive of Applicant's services. Because DOWNLOAD YOUR INSURANCE is one meaning of Applicant's mark that is not merely descriptive in relation to Applicant's services, Applicant's mark should still be allowed for registration.

**V. SUMMARY**

In light of all of the foregoing, Applicant respectfully requests that the decision of the Examining Attorney regarding her position with respect to the pending application be reversed, and the application be approved for publication.

Respectfully submitted,

LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK, LLP  
600 South Avenue West  
Westfield, NJ, 07090-1497  
Telephone: (908) 654-5000  
Facsimile: (908) 654-7866  
*Attorneys for Applicant Salvador Cababie*

Dated: December 8, 2015

By: /Gregg A.Paradise/  
Gregg A. Paradise

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